

**RECEIVED
CENTRAL FAX CENTER****JAN 28 2008****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

First Named Applicant: Toyoshima)	Art Unit: 2616
)	
Serial No.: 09/972,760)	Examiner: Nguyen
)	
Filed: October 5, 2001)	50P4257.03
)	
For: MULTIPLE WIRELESS FORMAT PHONE)	January 27, 2008
SYSTEM AND METHOD)	750 B STREET, Suite 3120
)	San Diego, CA 92101
)	

SUBSTITUTE APPEAL BRIEF

Commissioner of Patents and Trademarks

Dear Sir:

This brief is submitted under 35 U.S.C. §134 and is in accordance with 37 C.F.R. Parts 1, 5, 10, 11, and 41, effective September 13, 2004 and published at 69 Fed. Reg. 155 (August 2004). This brief is further to the Notice dated January 24, 2008 to correct claim 18 in Appendix A.

Table of Contents

<u>Section</u>	<u>Title</u>	<u>Page</u>
(1)	Real Party in Interest.....	2
(2)	Related Appeals/Interferences.....	2
(3)	Status of Claims.....	2
(4)	Status of Amendments.....	2
(5)	Summary of Claimed Subject Matter	2
(6)	Grounds of Rejection to be Reviewed.....	4
(7)	Argument.....	4
App.A	Appealed Claims	
App.B	Evidence Appendix	
App.C	Related Proceedings Appendix	

1168-105.APP

CASE NO.: 50P4257.03
Serial No.: 09/972,760
January 27, 2008
Page 2

PATENT
Filed: October 5, 2001

(1) Real Party in Interest

The real parties in interest are Sony Corp. and Sony Electronics, Inc.

(2) Related Appeals/Interferences

An appeal has been lodged in serial no. 09/972,183 which may be related.

(3) Status of Claims

Claims 1-5, 10, 11, 13, 15, 17-19, and 21 are pending and finally rejected, which rejections are appealed, and claims 6-9, 12, 14, 16, and 20 have been canceled.

(4) Status of Amendments

No amendments are outstanding.

(5) Summary of Claimed Subject Matter

As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.

Claim 1 sets forth a method for providing a multiple format wireless phone which includes formatting a wireless module (reference numeral 200, figure 1; page 4, line 12), with the wireless module storing a first wireless communication format. The method includes removably engaging the wireless module with a wireless

1168-105.A/P

CASE NO.: 50P4257.03
Serial No.: 09/972,760
January 27, 2008
Page 3

PATENT
Filed: October 5, 2001

phone (150, figure 1; page 4, line 24) having a second wireless communication format different from the first format. The wireless module has a mobile station identification number (page 6, line 16), and the method further includes storing the mobile station identification number to the wireless phone only upon determination that the wireless module provides proper operation in an intended area to facilitate communication using a common phone number with either format (page 6, lines 1-20).

Claim 11 requires a system for providing a multiple format wireless phone (150, figure 1; page 4, line 24). The system includes a wireless phone (150) having a first wireless communication format configured to removably receive a wireless module (200, figure 1; page 4, line 12) having a second wireless communication format. The wireless module is in electronic data communication with the wireless phone and is configured to provide the second format to the phone. The module includes a mobile station identification number (page 6, line 16), and the wireless phone is configured to receive the mobile station identification number upon verification of proper operation of the module to facilitate use of a single phone number with both formats (page 6, lines 14-20).

Claim 17 recites a multiple format wireless phone (150, figure 1; page 4, line 24) having a wireless module (200, figure 1; page 4, line 12) configured to store first operational data, with the phone being configured with second operational data different from the first. The wireless module is configured to be removably connected to the multiple format wireless phone. The operational data in the module includes a mobile station serial number (page 6, line 16), and the multiple format wireless phone is configured to receive the mobile station serial number upon verification of proper operation of the module in an intended area (page 6, lines 14-20).

1168-105.APP

CASE NO.: 50P4257.03
Serial No.: 09/972,760
January 27, 2008
Page 4

PATENT
Filed: October 5, 2001

(6) Grounds of Rejection to be Reviewed on Appeal

(a) Independent Claims 1, 11, 17 and dependent Claim 18 have been rejected under 35 U.S.C. §102 as being anticipated by Hanawa et al., USPN 5,450,471.

(b) Dependent Claims 2-5, 10, 13, 15, 19, and 21 have been rejected under 35 U.S.C. §103 as being unpatentable over Hanawa et al. in view of Metroka, USPN 5,249,302.

(7) Argument

As an initial matter, it is noted that according to the Patent Office, a new ground of rejection in an examiner's answer should be "rare", and should be levied only in response to such things as newly presented arguments by Applicant or to address a claim that the examiner previously failed to address, 69 Fed. Reg. 155 (August 2004), see, e.g., pages 49963 and 49980. Furthermore, a new ground of rejection must be approved by the Technology Center Director or designee and in any case must come accompanied with the initials of the conferees of the appeal conference, *id.*, page 49979.

a(1) Anticipation Rejection, Independent Claims 1 and 17 and Dependent Claim 18

Claim 1 requires storing the mobile station identification number to the wireless phone *only upon determination that the wireless module provides proper operation in an intended area*, to facilitate communication using a common phone number with either format. Elements 9 and 10 of Hanawa et al. have been relied on for this element but all the portions cited in the Office Action disclose is that element 9 provides communications conditions and the subscriber's number, without any evident conditions on this

1168.105 APP

CASE NO.: 50P4257.03
Serial No.: 09/972,760
January 27, 2008
Page 5

PATENT
Filed: October 5, 2001

provision, much less the one claimed. The allegation in the rejection that the mobile station ID is received upon verification of proper operation appears to be incorrect, because nothing in the relied-upon portions of the reference mention verifying anything, much less as a condition for providing a number. Instead, the element 9 simply provides, apparently as a package, communication conditions together with a subscriber number.

For convenience, here is what Hanawa et al. states regarding the relied-upon elements 9 and 10, which in fact make several points favorable to Application's position:

"The identifying means 9 of the buffer unit 7 identifies the communication conditions such as the radio frequency and the control channel for the connection, and also identifies the subscriber's number and the like. The communication conditions and the subscriber's number identified by the identifying means 9 are transmitted to the communication unit body 1 via the control signal transmitting means 10. The communication control part 4 of the communication unit body 1 changes the communication conditions to those conforming to the communication conditions of the portable telephone 8 or, converts the communication conditions. Accordingly, it is possible to use the portable telephone 8 as an automobile telephone. In this case, the communication is made using the subscriber's number of the portable telephone 8, so that the accounting is made to the subscriber of the portable telephone 8. On the other hand, if the communication is made using the subscriber's number of the automobile telephone, that is, the communication unit body 1, the accounting is made to the subscriber of the automobile telephone", Hanawa et al., col. 9, lines 48-68.

Leaving aside for the moment whether "changing the radio frequency and the control channel" is or is not the same thing as "changing formats", the relied-upon portion of Hawana et al. explicitly teaches that the frequency and control are changed as necessary to match the wireless telephone 13, used as the claimed "wireless module." Nothing is stated that this is done only after making a determination of anything, much less making a determination that the module provides proper operation in an intended area, much less still that

1168-105.A1P

CASE NO.: 50P4257.03
Serial No.: 09/972,760
January 27, 2008
Page 6

PATENT
Filed: October 5, 2001

instead of changing frequency and channel upon such an untaught determination, something different - the storage of a mobile station ID number - is accomplished.

Accordingly, the allegation on page 5 of the Office Action (relying on Hanawa et al., figure 6, elements 9 and 10, the disclosure of which is repeated above) that a mobile identification number is stored to the relied-upon wireless phone upon determination of proper operation simply is wrong with respect to Claims 1 and 17. Furthermore, with particular respect to Claim 1 it is incomplete, because it declines to address the "only" limitation of Claim 1.

Turning now to the question of multiple formats, as opposed to multiple frequencies/control channels, it appears to be the examiner's position that more is required than a frequency to make a format because he refers to col. 3, lines 9-13 consistently throughout the Office Action as a teaching of first and second formats. What is telling is that this part of Hanawa et al. is a background discussion that simply observes that one wireless system might use analog and another might use digital. It nowhere contemplates that the ensuing invention be used in some way to use both with a single device. Accordingly, the relied-upon teaching of multiple formats in Hanawa et al. is nowhere tied in to the subsequently relied-upon components of Hanawa et al. in the rejection, depriving the rejection of the cohesiveness required for legitimacy.

The above cogent points have been responded to (as best as Appellant can ascertain from the poor grammar and spelling in the latest Office Action, evincing a disturbing absence of supervisory attention) by a bare conjecture that Hanawa et al. meets the claimed limitation of verification because it "must". Well, if it "must" undertake the claimed limitation, Hanawa et al. certainly does not appear to say so, and the examiner has been unable to muster a citation to Hanawa et al. in support of his conjecture. In other words, the examiner's retort is a simple refusal, shorn of any evidence of record, to recognize right answer when told.

1168 105 APP

CASE NO.: 50P4257.03
Serial No.: 09/972,760
January 27, 2008
Page 7

PATENT
Filed: October 5, 2001

The examiner next resorts to another unsupported decree that has no roots in any evidence of record, namely, an insistence that the claimed "changing formats" is the same thing as changing between analog and digital. However, no evidence of record has been proffered that one skilled in the art would so construe the limitations at issue, rendering the examiner's evident claim construction defective under MPEP §2111.01.

Appellant reserves the right to respond to whatever point the top of page 6 of the Office Action attempts to make until such time as the examiner's position is cast in more comprehensible form.

a(2) Anticipation Rejection, Independent Claim 11

In addition to the arguments above and with further respect to Claim 11, the rejection nowhere alleges (because it cannot) that use of a single phone number with both formats is taught or suggested in Hanawa et al. Indeed, more likely the opposite: "communication is made using the subscriber's number of the portable telephone 8, so that the accounting is made to the subscriber of the portable telephone 8. On the other hand, if the communication is made using the subscriber's number of the automobile telephone, that is, the communication unit body 1, the accounting is made to the subscriber of the automobile telephone", id.

b Obviousness Rejections of Certain Dependent Claims

In addition to the dependent claims inheriting the patentability of their independent claims for reasons set forth above, there is no fair prior art suggestion to modify Hanawa et al. by removing its analog system and replacing it with what would be the duplicate digital system of Metroka for the simple reason that in

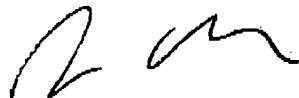
1168.105.APP

CASE NO.: 50P4257.03
Serial No.: 09/972,760
January 27, 2008
Page 8

PATENT
Filed: October 5, 2001

Hanawa et al., removing its analog capability as in essence proposed by the examiner would defeat a purpose of Hanawa et al. and, hence, be improper under MPEP §2143.01 (citing In re Gordon).

Respectfully submitted,



John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

JLR:jg

1168-105.APP

CASE NO.: 50P4257.03
Serial No.: 09/972,760
January 27, 2008
Page 9

PATENT
Filed: October 5, 2001

APPENDIX A - APPEALED CLAIMS

1. A method for providing a multiple format wireless phone, said method comprising:

formatting at least one wireless module, the wireless module storing at least a first wireless communication, format;

removably engaging the wireless module with a wireless phone having a second wireless communication format different from the first format;

said wireless module having a mobile station identification number, the method further including storing said mobile station identification number to said wireless phone only upon determination that the wireless module provides proper operation in an intended area to facilitate communication using a common phone number with either format.
2. A method for providing a multiple format wireless phone as recited in Claim 1, wherein formatting at least one wireless module comprises utilizing at least one wireless format selected from the group consisting of CDMA ONE, CDMA 2000 1X, CDMA 2000 3X, CDMA 1X EV, Wideband CDMA, GSM, GPRS and EDGE.
3. A method for providing a multiple format wireless phone as recited in Claim 1, wherein providing the wireless phone with said wireless module comprises providing said wireless module with at least one wireless format selected from the group consisting of CDMA ONE, CDMA 2000 1X, CDMA 2000 3X, CDMA 1X EV, Wideband CDMA, GSM, GPRS and EDGE.

1168-1015.APP

CASE NO.: 50P4257.03
Serial No.: 09/972,760
January 27, 2008
Page 10

PATENT
Filed: October 5, 2001

4. A method for providing a multiple format wireless phone as recited in Claim 1, further comprising providing said wireless module with an electronic serial number.

5. A method for providing a multiple format wireless phone as recited in Claim 4, further comprising storing said electronic serial number.

10. A method for providing a multiple format wireless phone as recited in Claim 5, wherein storing said electronic serial number comprises storing said electronic serial number to said wireless phone.

11. A system for providing a multiple format wireless phone, said system comprising:

a wireless phone having a first wireless communication format configured to removably receive at least one wireless module having a second wireless communication format; and

said wireless module in electronic data communication with said wireless phone, said wireless module configured to provide the second format to the phone, wherein said module includes a mobile station identification number, said wireless phone configured to receive said mobile station identification number upon verification of proper operation of the module to facilitate use of a single phone number with both formats.

1106-105.APP

CASE NO.: 50P4257.03
Serial No.: 09/972,760
January 27, 2008
Page 11

PATENT
Filed: October 5, 2001

13. A system for providing a multiple format wireless phone as recited in Claim 11, wherein said wireless format is selected from the group consisting of CDMA ONE, CDMA 2000 1X, CDMA 2000 3X, CDMA 1X EV, Wideband CDMA, GSM, GPRS and EDGE.

15. A system for providing a multiple format wireless phone as recited in Claim 11, wherein said module includes operational data comprising an electronic serial number, said wireless phone configured to store said electronic serial number.

17. A multiple format wireless phone comprising at least one wireless module configured to store first operational data with the phone configured with second operational data different from the first, said wireless module configured to be removably connected to the multiple format wireless phone, wherein said operational data in said module comprises a mobile station serial number, the multiple format wireless phone being configured to receive said mobile station serial number upon verification of proper operation of the module in an intended area.

18. A multiple format wireless phone as recited in Claim 17, wherein said first and/or second operational data comprises at least one wireless format.

19. A multiple format wireless phone as recited in Claim 18, wherein said operational data further comprises an electronic serial number, the multiple format wireless phone configured to store said electronics serial number.

1168-105.APP

CASE NO.: 50P4257.03
Serial No.: 09/972,760
January 27, 2008
Page 12

PATENT
Filed: October 5, 2001

21. A multiple format wireless phone as recited in Claims 18, wherein said wireless format is selected from the group consisting of CDMA ONE, CDMA 2000 DC, CDMA 2000 3X, CDMA TX EV, Wideband CDMA, GSM, GPRS and EDGE.

1168 105.AFP

CASE NO.: 50P4257.03
Serial No.: 09/972,760
January 27, 2008
Page 13

PATENT
Filed: October 5, 2001

APPENDIX B - EVIDENCE

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

1168-105.APP

CASE NO.: 50P4257.03
Serial No.: 09/972,760
January 27, 2008
Page 14

PATENT
Filed: October 5, 2001

APPENDIX C - RELATED PROCEEDINGS

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.

1168-105.AFT